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11/27/02



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of

§

S. Krishnaswamy

§

Art Unit: 2152

Serial No: 09/049,676

§

Examiner: J. Cardone

Filed: March 27, 1998

§

For: MULTI-PROTOCOL
COMMUNICATION
SUBSYSTEM CONTROLLER

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REPLY BRIEF

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REPLY TO EXAMINER'S ANSWER UNDER 37 CFR 1.193(B)

Appellant respectfully requests withdrawal of the final rejection, re-opening of prosecution, and allowance of the above-captioned application. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgment of receipt and entry of this Reply Brief is requested.

INTRODUCTION

Appellant responds herein to the rejection under 35 U.S.C. § 103. Based on a review of the Examiner's Answer mailed September 27, 2001, and in particular, new points raised for the first time in the Examiner's Answer, it appears that the rejection under 35 U.S.C. § 103 is based on a misapplication of the teaching of the combination of Choquier et al., U.S. Patent Number 5,777,668 (hereinafter Choquier), and Pearson, United States Patent Number 5,903,754 (hereinafter Pearson), as well as the inappropriate combination of Choquier and Pearson.

For the reasons set forth below, Appellant requests the Board of Patent Appeals and Interferences (the "Board") reverse the Examiner's rejections in the event that the rejections are not withdrawn prior to reaching the Board.

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35 U.S.C. § 103

Claims 1-34 stand rejected as being unpatentable over Choquier in view of Pearson.

A Prima Facie Case of Obviousness Has Not Been Established

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

The Office Action does not provide the requisite motivation.

In the Appeal Brief of July 10, 2001, Appellant provided arguments asserting the insufficiency of the cited motivation. These arguments are still applicable to the above rejection of record and are, accordingly, incorporated herein. However, for the sake of brevity, those arguments will not be repeated herein. Appellant respectfully requests that the Board consider these previous arguments in combination with the comments set forth below.

Appellant respectfully asserts that the original motivation cited in the First Office Action dated August 29, 2000, and maintained in the Final Office Action of February 12, 2001 and the Examiner's Answer of September 27, 2001 is still the motivation of record used to combine the references. This motivation is as follows:

"It would have obvious ... to incorporate the detailed protocol stack, shown by Pearson, in to the gateway system, taught by Choquier in order to easily disclosed the relationship of the layers. One of ordinary skill in the art would have been motivated to modify Choquier to include the detailed protocol stack in view of Pearson, so that a user could replicate the stack easily."

The commentary provided by the Examiner in the Examiner's Answer does not overcome the insufficiencies of this motivation.

The Examiner states that Choquier provides a skeletal view of the interfaces between protocol layers that is inefficient, and a further/deeper view of the relationships of the

protocol are desirable or advantageous to the operation of the system. Appellant respectfully asserts that the view provided by Choquier is not ‘skeletal’, but rather does not teach all elements of the claimed invention, e.g. the communication subsystem controller. The system of Choquier is complete and operates in its own fashion, and does provide communications between the protocol layers, for example see FIGURE 5A of Choquier. Moreover, the Examiner has not provided any evidence or logical reason why a further/deeper view is desirable or advantageous to Choquier.

The Examiner then states that Pearson teaches relationships between the protocol layers and the use of a controller. The Examiner further states that Pearson discloses building a protocol stack using the plurality of protocol layers and the communication subsystem controller. The Examiner then states that it would have been obvious ... to incorporate the detailed relationships of the protocol layers of the stack, shown by Pearson, into the gateway system, taught by Choquier, since Pearson discloses communications between computers, similar to communications with client/server computers found in Choquier ... that is improved by dynamically creating and recreating protocol layers and their interfaces within the computers. Appellant respectfully asserts that any lack of detail in Choquier is not a rationale for including the stack builder of Pearson. Moreover, the Examiner has not shown any technical basis for the assertion that the teachings of Pearson would benefit the system of Choquier in any way. Appellant notes that moving to a dynamic system does not automatically increase system performance, as there are costs associated with a dynamic system, e.g. resources are required to be allocated for the dynamic operations, and system hold times may increase while waiting for the dynamic operations to complete. Thus, this reasoning is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01.

The Examiner further states that one of ordinary skill in the art would have been motivated to modify Choquier to include modifying the stack in view of Pearson, so the system would be more versatile and open for operators to easily manipulate the system upon

the layer scale. Appellant again respectfully asserts that the Examiner has not shown how the system of Choquier is benefitted by the teachings of Pearson. The Examiner has not shown how Choquier is not versatile or open to change. Thus, this reasoning is also circular in nature, as discussed above.

The Appellant further notes that these comments by the Examiner cannot be replacement motivation for the motivation of record, because replacement motivation would constitute a new grounds of rejection, which is prohibited in an Examiner's Answer, see M.P.E.P. § 1208.01. Appellants note that motivation is a required element of a rejection under 35 U.S.C. § 103, see M.P.E.P. § 2143.01, and that a change in the motivation would therefore constitute a new and different rejection. Thus, Appellant believes that these comments by the Examiner should only be viewed as comments regarding the motivation of record and not replacement or supplemental motivational statements.

Thus, Appellant submits that the statements provided by the Examiner in the Examiner's Answer do not satisfy the deficiencies of the current motivation as discussed by Appellant in the Appeal Brief.

The recited combination does not teach or suggest all claimed limitations.

In the Appeal Brief of July 10, 2001, Appellant provided arguments asserting the insufficiency of the cited combination. These arguments are still applicable to the above rejection of record and are, accordingly, incorporated herein. However, for the sake of brevity, those arguments will not be repeated herein. Appellant respectfully requests that the Board consider these previous arguments in combination with the comments set forth below.

The commentary provided by the Examiner in the Examiner's Answer does not overcome the insufficiencies of the applied combination of Choquier and Pearson.

The Examiner states that Choquier teaches protocol layers within the client and the relationships with them. The Examiner then discusses the Microsoft connection layer or MCP layer (Appellant notes the Examiner has erroneously referred to this layer as the MPC layer instead of the MCP layer). The Examiner states that MCP layer has two layers and interfaces between these two layers. Appellant notes that this discussion by the Examiner does not read the layers of Choquier onto the claimed invention. Moreover, Appellant asserts

that the MCP layer is comprised of the two layers and while the two layers may communicate with each other, the MCP layer does not interface between them. The text of Choquier cited by the Examiner as supporting his position does not provide such a teaching.

The Examiner has also cited a series of cases and their general propositions. Appellant, while not specifically agreeing with propositions as listed by the Examiner, notes that the cases have been cited without applying them to the specific facts at hand. Therefore, the listing of cases does not refute the arguments made by Appellant in the Appeal Brief.

The Examiner then states that Appellant argues the patentability of the claims by individually addressing the references used to reject the claims. The Examiner then states that Appellant cannot show non-obviousness by attacking the references individually where, as here the rejections are based on a combination of references, and cites *In re Keller*, 208 U.S.P.Q. 871 (CCPA 1981). Appellant respectfully disagrees. Appellant, in the Appeal Brief, is addressing the readings of the references with respect to the claim limitations as defined by the Examiner. Appellant is identifying the inconsistencies with the Examiner's readings of the claim limitations on the cited references. Appellant is not individually addressing the references as in *In re Keller*, wherein an affidavit was offered as evidence which only discussed one reference of a combination of references, *Id.* at 882. In the arguments presented by Appellant in the Appeal Brief, both references, namely Choquier and Pearson, are discussed, not just one reference.

Thus, Appellant submits that the statements provided by the Examiner in the Examiner's Answer do not satisfy the deficiencies of the combination of Choquier and Pearson as discussed by Appellant in the Appeal Brief.

CONCLUSION

This Reply Brief was required to address issues first made apparent by new points set forth in the Examiner's Answer. Appellant apologizes to the members of the Board for the length of this Reply Brief. It is hoped that the Primary Examiner will review this Reply and withdraw the final rejection and re-open prosecution rather than burden the Board with this appeal. Appellant requests the Primary to so reopen prosecution and allow this application.

Failing that, Appellant respectfully requests the Board to reverse the Examiner's rejection for the all the reasons set forth herein and as set forth in the Brief on Appeal.

Respectfully submitted,



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